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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/699,098	10/27/2000	Frederick S. M. Herz		7141

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EXAMINER

MAHMOUDI, HASSAN

ART UNIT PAPER NUMBER

2165

DATE MAILED: 04/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/699,098	Applicant(s) HERZ ET AL.	
	Examiner Tony Mahmoudi	Art Unit 2165	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's Request for Continued Examination (RCE) submission and its accompanying declaration under 37 C.F.R. § 1.131, filed on 13-February-2006 have been entered.

Remarks

2. In response to communications filed on 13-February-2006, claims 3-12 are presently pending in the application, of which, claim 3 is presented in independent form.

Response to Declaration Filed Under 37 C.F.R. § 1.131

3. The declaration under 37 C.F.R. § 1.131 filed on 13-February-2006 has been considered but is ineffective to overcome the Bowman-Amuah reference (US 6,697,824 B1) as prior art for the instant application:

Based on the evidence supplied, it appears that the applicant is relying on *conception* prior to the effective date of the reference, followed by *diligence* until the US filing date. However, the submitted evidence is insufficient to establish a conception of the invention prior to the effective date of the Bowman-Amuah reference. While the applicant has provided a claim chart (exhibit B), mapping the individual limitations of claim 1 of the instant application to the detailed document (exhibit A), the examiner cannot establish the date of the document (exhibit A), therefore, cannot establish a valid conception based on the provided document.

Further, the applicant stated diligence in the declaration but did not provide any dated document(s) in support of the diligence statement (e.g. dated correspondence between applicants and patent counsel, etc.) Per MPEP 715.07(a), “[w]here conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. Ex parte Hunter, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence.” In this case, evidence of facts establishing diligence has not been shown by the applicant.

In view of the above requirements set forth by the MPEP for proving “conception” and “diligence”, the examiner is maintaining the validity of the reference(s) cited in the previous and the present Office Actions as appropriate “prior art” to the claims of the present invention.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 3-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Bowman-Amuah (U.S. Patent No. 6,697,824 B1.)

As to claim 3, Bowman-Amuah teaches a method of allowing access to data over a distributed data processing system (see Abstract, and see column 22, lines 63-67), comprising:

- (a) providing an automated infrastructure for the exchange of information between multiple self-interested parties (see column 25, lines 6-11, and see column 26, lines 12-29);
- (b) providing a trusted server (see column 72, lines 44-64) with at least one data warehouse for the storage of the information (see column 74, lines 18-30);
- (c) associating a price rule with particular data records of the information which establishes a cost of accessing the particular data records, and which controls the access to

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that data (see column 27, lines 22-53, see column 61, line 28 through column 62, line 5, and see column 78, line 56 through column 79, line 25);

(d) wherein the price rule enables a data owner associated with the data to specify a different price for different types and amounts of information access (see column 61, line 28 through column 62, line 5);

(e) within the trusted server, providing a data processing platform which is accessible to multiple third-party data processing software programs which operate as software agents (see column 42, line 65 through column 43, line 4, and see column 47, line 12 through column 48, line 9);

(f) wherein a plurality of seller-side software agents have defined relationships to the price rules and associated data records, and maintain absolute access control to the data records (see column 26, lines 30-40, see column 31, lines 17-23, and see column 34, lines 6-22);

(g) wherein a plurality of buyer-side software agents have regulated query access to the data processing platform and may request pricing information from the seller-side software agents (see column 36, lines 7-46, and see column 52, lines 22-45);

(h) wherein the plurality of seller-side software agents and the plurality of buyer-side software agents operate as persistent data processing systems which interact with one another repeatedly over time and which thus define a virtual marketplace (see column 26, lines 42-56, see column 28, line 65 through column 29, line 11, and see column 38, lines 58-67.)

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As to claim 4, Bowman-Amuah teaches wherein the trusted server is accessed via a network (see column 72, lines 45-64.)

As to claim 5, Bowman-Amuah teaches wherein the network is a wireless network (see column 20, line 62 through column 21, line 9.)

As to claim 6, Bowman-Amuah teaches wherein the network is a cellular network (see column 20, line 62 through column 21, line 9.)

As to claim 7, Bowman-Amuah teaches wherein the network is the Internet (see figure 33, and see column 74, lines 19-30.)

As to claim 8, Bowman-Amuah teaches wherein the software agents are associated with at least one individual (see column 28, line 53 through column 29, line 11.)

As to claim 9, Bowman-Amuah teaches wherein the software agents are associated with at least one company (see column 26, lines 31-40.)

As to claim 10, Bowman-Amuah teaches wherein the cost of accessing the particular data records is the price that the buyer-side software agents must pay before accessing the particular data records (see column 79, lines 11-16.)

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As to claim 11, Bowman-Amuah teaches wherein the information access is encrypted through the use of a security certificate (see column 45, lines 15-25, see column 62, lines 14-17, and see column 81, line 37 through column 82, line 39.)

As to claim 12, Bowman-Amuah teaches wherein the security certificate is managed by a public key infrastructure (see column 71, lines 1-37.)

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 1 is further rejected under 35 U.S.C. 103(a) as being unpatentable over Bowman-Amuah (U.S. Patent No. 6,697,824 B1) in view of Shoham (U.S. Patent No. 6,285,989 B1.)

In the *Remarks* section of the response filed on 13-February-2006, the applicant argued that, “claims 3-12 patentably distinguish over Bowman-Amuah”. The examiner has established (in the above 102(e) rejection) that Bowman-Amuah is a valid 102(e) reference which meets all the limitations of claims 3-12 of the instant application. Nonetheless, the applicant’s arguments are fully considered, hence introducing this new ground for rejection under 35 U.S.C. § 103(a):

In the presented arguments, the applicant states that “determining the price for purchasing a product”, as taught by Bowman-Amuah, “is not the same as ‘associating a price rule with...data records to establish the cost of data records and control access to that data’”.

However, Shoham teaches a universal on-line trading market design and development system (see Abstract), in which he teaches associating a price rule with particular data records (item) of the information (see column 6, lines 10-21; see column 14, lines 17-24) which establishes a cost of accessing the particular data records, and which controls the access to that data (the “item price” established by the “pricing rule” controls access to that item, where the access is given to the buyer who matches or exceeds the required price); and he further teaches wherein the price rule enables a data owner associated with the data to specify a different price for different types and amounts of information access (see column 2, lines 29-34.)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Bowman-Amuah by the teaching of Shoham, because associating a price rule with particular data records where the associated price controls the access to the records, and where the price could be adjusted (increased or decreased), would provide for conducting Internet commerce, Online-shopping, and electronic auctions. Pricing rule controls the price of the record/item and can offer a variety of options such as “(uniform price [lowest accepted or highest rejected], or pay-your-bid, or Vickrey rule), static or dynamic (sealed bid versus ascending prices)”, as taught by Shoham (see column 6, lines 13-17.)

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Response to Arguments

8. Applicant's arguments filed on 13-February-2006 with respect to the rejected claims in view of the cited references have been fully considered but they are moot in view of the new grounds for rejection.


Conclusion

9. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Tony Mahmoudi whose telephone number is (571) 272-4078. The examiner can normally be reached on Mondays-Fridays from 08:00 am to 04:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin, can be reached at (571) 272-4146.

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March 6, 2006


JEFFREY GAFFIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100